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10/054,173	01/18/2002	Brian J. Malone	067276-1037	4542
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FOLEY AND LARDNER LLP			CHOI, JACOB Y	
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BRIAN J. MALONE, TODD M. NYKERK, and  
TIMOTHY J. KELLY

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Appeal 2009-003894  
Application 10/054,173  
Technology Center 2800

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Decided: August 27, 2009

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Before JEFFREY T. SMITH, LINDA M. GAUDETTE, and,  
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-6, 8-10, 12-23, 25, 26, and 28-34.<sup>1</sup> (App. Br. 4). We have jurisdiction pursuant to 35 U.S.C. § 6(b).<sup>2</sup>

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<sup>1</sup> Claims 7, 11, 24, and 27 have been canceled. (App. Br. 4). Claim 6 is not listed by the Examiner in any ground of rejection, but is included in the list

We REVERSE.

### THE INVENTION

Appellants' claimed invention is directed to a method of manufacturing a lamp housing, as well as to a lamp housing. Claims 1 and 16, reproduced below, are representative of the subject matter on appeal.

1. A method of manufacturing a conductive lamp housing, comprising depositing particles by direct metallization to form a layer of conductive material on a generally non-planar surface of a substrate that forms part of the lamp housing, in order to form part of one or more electrical spray circuits when said conductive material is connected to at least one or more power sources and one or more light sources.
16. A lamp housing comprising a substrate, further comprising a conductive layer for one or more electrical circuits deposited directly on said substrate, wherein said conductive layer is 1 to 4 microns thick.

### THE REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Elarde	4,532,152	Jul. 30, 1985
Suzuki	6,290,380 B1	Sep. 18, 1985

Appellants' Admission of Prior Art, Specification, pp. 6, 7 (hereafter, AAPA)

Appellants appeal the following rejections:

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of claims rejected (*see* cover sheet of Final Rej. mailed Jan. 23, 2006; App. Br. 4; Ans. 2).

<sup>2</sup> In this decision we have considered Appellants' arguments presented in the Briefs filed October 23, 2006 and April 2, 2007.

Claims 1, 8-10, 12-20, 22, 23, 25, 26, and 28-32 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Suzuki and Elarde.

Claims 2-5, 21, 33, and 34 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Suzuki, Elarde, and AAPA.

#### ISSUE

The dispositive issue before us is whether the Examiner has reversibly erred in not considering the rebuttal evidence along with the facts on which the conclusion of *prima facie* obviousness was reached. We answer this question in the affirmative. Therefore, we REVERSE.

#### OPINION

“After a *prima facie* case of obviousness has been made and rebuttal evidence submitted, all the evidence must be considered anew.” *In re Eli Lilly & Co.*, 902 F.2d 943, 945 (Fed. Cir. 1990) (citing *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984)); *Piasecki*, 745 F.2d at 1472 (“*Prima facie* obviousness is a legal conclusion, not a fact. Facts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself.” (internal cites omitted)); *see also* MPEP § 716.01(d).

In support of the nonobviousness position, Appellants proffered a Declaration by Todd Nykerk, filed on March 16, 2004<sup>3</sup> (*see* Evidence Appendix of the Brief).

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<sup>3</sup> The Examiner entered the Nykerk Declaration filed “under 37 C.F.R. [§] 1.132” but dismissed it as “only opinion” (*see* Advisory Action dated April 4, 2004, p. 2).

According to Appellants, the Nykerk Declaration “explains in detail why a person of ordinary skill . . . would not understand the prior art to teach or suggest a conductive layer 1 to 4 microns thick deposited directly on a lamp housing” (App. Br. 10); is “not mere opinion” (App. Br. 14); discusses “various problems with the complex process disclosed in Suzuki” which the Examiner “improperly dismissed” and “ignored the supporting facts” therein (Reply Br. 3); and identifies “design considerations” in the lamp assembly art which the Examiner does not address (Reply Br. 4; *see also* Reply Br. 8).

The Examiner's consideration of the Nykerk declaration consists of the following paragraph which bridges pages 15 and 16 of the Answer:

the declaration of Todd Nykerk included in the Appeal Brief filed on October 23, 2006 is fully considered by the examiner, but insufficient to overcome the rejection of claims 1-6, 8-10, 12-23, 25, 26 and 28-34, because failed to depend upon the amount of factual evidence to support the conclusion of enablement. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991)[.] The expert's opinion on the ultimate legal conclusion must be supported by something more than a conclusory statement; cf. *In re Alton*, 76 F.3d 1168, 1174, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996).

(Ans. 15, 16)

The Examiner's response to Nykerk Declaration is largely dismissive.<sup>4</sup> In fact, even though Appellants' Briefs place extensive reliance on the Nykerk Declaration to overcome the *prima facie* case, the Examiner's Answer never addresses it in any detail. This is improper. Whether the

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<sup>4</sup> Further, no rejection of the claims has been made based on a failure to comply with the enablement requirement. Thus, the relevance of the Examiner's remark concerning “factual evidence to support the conclusion of enablement” is not apparent.

claimed invention would have been obvious cannot be determined without considering evidence attempting to rebut the *prima facie* case. Manifestly, the Examiner's consideration and treatment of the Nykerk declaration is improper, since the Examiner has not reweighed the entire merits of the matter. Rather, he has dismissed the evidence of nonobviousness in a cursory manner. Since the Examiner did not properly consider the submitted evidence, the rejection cannot be sustained.

For the foregoing reasons, the rejections of claims 1-6, 8-10, and 12-23, 25, 26, and 28-34 under 35 U.S.C. § 103(a) are reversed.

**ORDER**

The Examiner's decision rejecting claims 1-6, 8-10, and 12-23, 25, 26, 28-34 is reversed.

**REVERSED**

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